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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/603,533      | 06/25/2003  | Dahv A. V. Kliner    | SD8317.2            | 4131             |

7590 03/19/2004  
Timothy Evans  
Sandia National Laboratories  
MS 9031  
7011 East Avenue  
Livermore, CA 94550

EXAMINER

HOFFMANN, JOHN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1731

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/603,533

**Applicant(s)**

KLINER ET AL

**Examiner**

John Hoffmann

**Art Unit**

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6 and 8-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-6, 8-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-9, and 11-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support for the amendment of claim 8 which requires that the removing of the fiber rods is part of the inserting step. The specification only discusses that after the fiber bundle is inserted, then some of the fibers are removed.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-9 and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 requires that the inserting the bundle into the glass tube "thereby" forming a preform assemble. However, claim 8 requires that to insert the fibers, one must perform an operation on the preform assembly. Examiner does not understand this. One cannot remove any fiber from the preform assembly until after the preform assembly actually exists. But claim 1 requires the assembly is a result of the inserting. Thus Examiner cannot understand what occurs first: the creation of the preform assembly, or the removal of the fibers from the assembly.

### ***Claim Objections***

Claims 8-9, and 11-13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 1 requires that first glass rods are in the bundle/preform assembly and is fused to form a solid preform (see the last three lines and elsewhere). Claim 8 requires removing some of the first glass rods. The claims require two incompatible things. Claim 8 doesn't further limit a process which maintains all the rods, it takes it to a completely different scope - a scope where the rods are not maintained. Therefore

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claim 8 does not further limit claim 1. Claims 8-9 and 11-13 are not further treated on their merits.

Furthermore, as indicated above, one cannot remove fibers prior to the creation of the assembly – thus one cannot complete the insertion prior to the creation of the assembly. Claim 8 is of a completely mutually exclusive scope from that of claim 1.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3,5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hopkins 3395006.

Col. 1, lines 67-72 discloses the bundling and insertion of the bundle into a tube. Col. 4, line 48 discloses that the tube is glass. Col. 3, lines 39-47 disclose the two refractive indices

Hopkins discloses the invention as claimed. However, it is unclear whether the fibers are added as a bundle to the tube, or whether the fibers are added one at a time. It would have been obvious to add the fibers as a group, because it would be quicker

than adding them one at a time. The order of adding elements is generally not invention. It is inherent that there would be an average which is predetermined by the particular glass fibers used. AS to the composition of each rod being maintained in a position coincident with the glass rods: a rod has to be coincident with itself - otherwise it is in two locations at the same time. Figure 6 shows the step of heating.

Claim 3 is clearly met as per figure 6.

Claim 5: figure 4 shows a random distribution. Alternatively, it would have been obvious to load the fibers randomly, because it is easier and quicker than assigning each fiber in its own spot - since the fibers are all identical.

Claim 6: see figure 2, which shows an orderly (non-random) arrangement.

### ***Response to Arguments***

Applicant's arguments filed 02 Feb 2004 have been fully considered but they are not persuasive.

It is argued the present invention is directed to having a single refractive index. Hopkins meets the present claim language – the rods do have a refractive index. The present claims are comprising in nature and the rods are open to have more than one refractive index. The fact that Hopkins has two indices does not diminish the fact that it has a refractive index.

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Contrary to the arguments, the claims do not require having a "single" refractive index. As to being from a set of two or more refractive indices, the claims don't require a group of additional rods from which one has to select particular rods.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

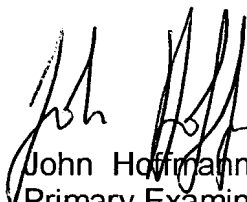
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John Hoffmann  
Primary Examiner  
Art Unit 1731  
3-16-04

jmh